

Appl. No. : 10/508,969
Filed : April 8, 2005

REMARKS

Claim 1 has been amended to clarify the invention. Support can be found at page 5, lines 4-5, for example. Claim 9 has been amended for consistency. Claim 15 has been added. Support can be found in the paragraph bridging pages 4 and 5, for example. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection of Claims 1, 3-5, 7-14 Under 35 U.S.C. § 102 (b) or § 103(a)

Claims 1, 3-5, 7-14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by or, alternatively, under 35 U.S.C. § 103(a) as being obvious over Winiker (5032226) as evidenced by Alfrey, Jr. et al ("Amphoteric Polyelectrolytes. II. Copolymers of Methacrylic Acid and Diethylaminoethyl Methacrylate" J.Am. Chem. Soc., v.74 (1952) pp438-441) and Alfrey, Jr.et.al ("Preparation and Titration of Amphoteric Polyelectrolytes" J. Polymer Sci., v 23 (1957) pp.533-547).

In the Advisory Action, the Examiner states:

The Examiner interprets the apparently opposing statements to mean that Applicant admits that the amphoteric polyacrylamide of Winiker probably or possibly has the claimed electric charge for some embodiments and does not have the claimed electric charge in other embodiments. *Lines 4-6 of the third paragraph on page 2.*

Applicant's point was that the assertion that the amphoteric polyacrylamide of Winiker probably or possibly has the claimed electric charge for some embodiments is insufficient to support a finding of inherency. As Applicant pointed out, it is well settled that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and inherency may not be established by probabilities or possibilities. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) Further, "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

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Winiker teaches that "the molecular ratio of acrylamide groups and/or methacryl amide groups relative to the sum of the anionic and cationic groups can have a value of from 60:40 to 95:5" (col. 4, lines 4-6), but Winiker does not teach any specific electric charge property. Applicant previously showed that the amphoteric polyacrylamide of Winiker (defined by a molecular ratio of acrylamide groups and/or methacryl amide groups relative to the sum of the anionic and cationic groups of from 60:40 to 95:5) can exceed the claimed electric charge, i.e., the amphoteric polyacrylamide of Winiker does not necessarily have the claimed electric charge. Thus, based on the well accepted test, the assertion that the amphoteric polyacrylamide of Winiker probably or possibly but unnecessarily has the claimed electric charge must be insufficient to establish inherency. The Examiner has not shown any sound basis for asserting that the amphoteric polyacrylamide of Winiker does necessarily have the claimed electric charge. Accordingly, the *prima facie* case of anticipation cannot be maintained. If this rejection is maintained, the Examiner is required to show a sound basis for asserting that the amphoteric polyacrylamide of Winiker necessarily has the claimed electric charge.

Further, claim 1 as amended herein recites "said amphoteric polyacrylamide having an average molecular weight of 2,500,000 or higher." The polyacrylamides can improve the paper strength or a bulky paper without affecting its density and also cause the paper to manifest good optical characteristics. Page 3 lines 5-7.

Winiker states: "The molecular weight of the amphoteric polyacryl amide is in the area of from 100,000 to 2,000,000, and is preferably between 500,000 and 1,500,000." *Col. 6, lines 8-10*. Further, Winiker uses amphoteric polyacrylamides for structural strength and flocculation-suppressing properties. *Col. 3, lines 61-65*.

In *Optivus Technology, Inc. v. Loma Linda University Medical Center*, 469 F.3d 978 (2006 U.S. App.), the Court noted that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." Based on that test, Winiker teaches away from "the average molecular weight of 2,500,000 or higher" recited in claim 1 because Winiker specifically states that the molecular weight is in the area of from 100,000 to 2,000,000, preferably between 500,000 and 1,500,000

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for structural strength and flocculation-suppressing properties, and thus the ordinary skilled artisan would be discouraged from using the average molecular weight of 2,500,000 or higher for paper strength. Further, Winiker is silent as to bulkiness without affecting its density and good optical characteristics. Alfrey Jr. et al. is irrelevant to the features discussed above.

Thus, not all of the limitations of claim 1 are taught or suggested by Winiker and Alfrey, Jr. et al. Accordingly, claim 1 cannot be *prima facie* obvious over Winiker and Alfrey, Jr. et al, alone or combined. At least for this reason, the remaining dependent claims also cannot be obvious over Winiker and Alfrey, Jr. et al, alone or combined. Applicant respectfully requests withdrawal of this rejection.

Rejection of Claims 2 and 6 Under 35 U.S.C. § 102 (b) or § 103(a)

Claims 2 and 6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Winiker in view of Tashiro and Schade.

Claims 2 and 6 depend ultimately from claim 1. Tashiro and Schade are irrelevant to the features of claim 1 discussed above, and thus, claim 1 cannot be obvious over Winiker, Tashiro, and Schade. At least for this reason, claims 2 and 6 cannot be obvious over the above references.

New claim 15

Claim 15 has been added and recites "the amphoteric polyacrylamide has an electric charge of 1.5 m-equivalent/g or less and a positive potential at pH 2 and has an electric charge of 1.8 m-equivalent/g or less and a negative potential at pH 12." The above ranges are not taught or suggested by the prior art and nonobviousness of the ranges is supported by the evidence shown in Tables 1-6 in the instant specification.

CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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